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09/699,244

10/27/2000

Amit D. Agarwal

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06/08/2005

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EXAMINER

NGUYEN, CUONG H

ART UNIT

PAPER NUMBER

3661

DATE MAILED: 06/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/699,244

Applicant(s)

AGARWAL, AMIT D.

Examiner

CUONG H. NGUYEN

Art Unit

3661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/03/2004 (the Interview Summary Paper).
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is the answer to the communication received on 8/03/2004.
2. The applicant elects without traverse claims 1-45 (the claims filed on 10/27/2000) for examination on 2/18/2004; this election is made final.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. **Claims 1-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over**

Robertson (US Pat. 6,609,106).

A. As to independent claim 1: Robertson teaches a system and a method for providing gift registry services over a distributed network (see Robertson, Fig.1), comprising:

- identifying/defining/displaying an item to a user (see Robertson, Fig.11, ref.64);
 - receiving an indication from a user to add the item to the gift being defined (see Robertson, Fig.14, refs.71,33; and Fig.4 ref. 132); and
 - in response, adding the item to the gift being defined (see Robertson, Fig.4, ref.132);
- receiving an indication from the user (merely selecting an option/a choice) of a category for the gift being defined (see Robertson, Fig.8, ref.218), and
- associating that category with the gift being defined (see Robertson, Fig.7 refs. 192, 198);

- storing each of the defined gifts for later use in ordering (see Robertson, Fig.4, ref.138, and Fig.7, ref.204); displaying stored information, and kind/categories of the gifts (see Robertson, Fig.11, ref.60); and
- after selection a displayed indication of identified gifts and an indication of a recipient (see Robertson, Fig.8, refs. 214-216), sending a request to order (see Robertson, Fig.2, ref.92, and Fig.7, ref.198).

Robertson does not disclose about “gift cluster”.

However, this term merely indicates different sub-categories of a wish list for gifts.

It would have been obvious to one of ordinary skill in the art at the time of invention to implement Robertson to classify a wish list into different sub-categories for a user to quickly indicate a preferred gift that related to a wish list for ordering.

B. As to claims 9, 39, 42, 44-45:

These claims are directed to a method to send gifts to a receiver with a single selection.

Claim 1 contains all limitations of independent claim 9; therefore, similar rationales and reference set forth are repeated herein for a rejection of claim 9 on obviousness.

Claim 9 contains all limitations of independent claims 39, 42, 44, 45 whether they are medium claim, or a system claim, or claiming a signal; therefore, similar rationales and reference set forth are repeated herein for a rejection of claims 39, 42, 44, 45 on obviousness.

B. As to dependent claims 2, 20: The rationales and reference for a rejection of claim 1 are incorporated.

The examiner respectfully submits that it is an old step to supply a product (e.g., a 27” Sony TV), and a shipping service (e.g., an overnight shipment service for that TV by FedEx).

C. As to dependent claims 3, 21: The rationales and reference for a rejection of claim 1 are incorporated.

The examiner respectfully submits that it is an old step to give different type of gifts (e.g., a 27" Sony TV), and a Lazy-Boy chair.

D. As to dependent claims 4-5: The rationales and reference for a rejection of claim 1 are incorporated.

The examiner respectfully submits that it is an old step to order gifts (in a wish-list) to send directly to a recipient by a credit card (e.g., <http://www.amazon.com>).

E. As to dependent claim 6: The rationales and reference for a rejection of claim 1 are incorporated.

The examiner respectfully submits that it is an old step to select and to display on computer by an input device; then doing repetition steps to a second recipient similarly to the first recipient (see the rationales for claim 1) – therefore, this is merely a routine repetition.

F. As to dependent claim 7: The rationales and reference for a rejection of claim 1 are incorporated.

Robertson suggests that a gift list is available for ordering by other users (see Robertson, the abstract for an online Gift Registry Service).

G. As to dependent claim 8: The rationales and reference for a rejection of claim 1 are incorporated.

The examiner respectfully submits that it is an old step to ship many purchased items in one shipment to a recipient.

H. As to dependent claim 10: The rationales and reference for a rejection of claim 1 are incorporated.

The examiner respectfully submits that it is an old step to ship many purchased items in one shipment to a recipient to reduce shipping costs.

I. As to dependent claim 11: The rationales and reference for a rejection of claim 9 are incorporated.

The examiner respectfully submits that it is an old step to send an order/acomunicate/a request to a server because it is a normal internal status reporting between satellite terminal to a central server.

J. As to dependent claims 12-14: The rationales and reference for a rejection of claim 9 are incorporated.

The examiner respectfully submits that it is an old step to display on an Internet-connected monitor screen an option/selection/choice a “YES”/”NO” for a decision of adding items to order later (please note that displaying “data” - whether that is a specific data – is obvious since “data” are considered as non-functional descriptive material for “displaying”).

K. As to dependent claims 15-19: The rationales and reference for a rejection of claim 9 are incorporated.

The examiner respectfully submits that it is an old step to interactively display and to receive on an Internet-connected monitor screen an option/selection/choice/user’s signal/decision. Further, because of using Internet for a practice of giving gifts – another user is accessible in addition to a user.

L. As to dependent claim 22: The rationales and reference for a rejection of claim 9 are incorporated.

The examiner respectfully submits that it is an old and well-known step to give same items as gifts among different givers (e.g., 2 Sony TVs).

M. As to dependent claims 23-25: The rationales and reference for a rejection of claim 9 are incorporated.

The examiner respectfully submits that it is obvious to contain shipping instructions, wrapping instruction, and displaying those details together with selected items because those details are merely non-functional descriptive materials that do not effect the containing/displaying steps of ordering items on Internet.

N. As to dependent claim 26: The rationales and reference for a rejection of claim 9 are incorporated.

The examiner respectfully submits that it is an old step to select an option by clicking a mouse while searching.

O. As to dependent claims 27-34, 38: The rationales and reference for a rejection of claim 9 are incorporated.

The examiner respectfully submits that it is old for Internet interactive searching steps as claimed by inputting specific categories and search criteria to find available items for ordering (please note that search criteria comprise non-functional descriptive material that are obvious from cited art).

P. As to dependent claim 35: The rationales and reference for a rejection of claim 9 are incorporated.

The examiner respectfully submits that it is old to define/group items according to a user.

Q. As to dependent claim 36: The rationales and reference for a rejection of claim 35 are incorporated.

The examiner respectfully submits that it is old to assist an Internet user by:

- displaying available gift items; then

- a user add a preferred item as his/her gift.

Those interactive steps are merely selecting items from an available list while Internet surfing

R. As to dependent claim 37: The rationales and reference for a rejection of claim 35 are incorporated.

The examiner respectfully submits that it is old to assist an Internet user by:

- inputting category information (e.g., kitchen items, photograph/decoration items, electronics etc.)

Those interactive steps are merely selecting items from an available list while Internet surfing

S. As to dependent claims 40-41, and 43: The rationales and reference for a rejection of claim 1 are incorporated.

- The examiner respectfully submits that it is obvious to put Robertson's computer instructions to a data transmission medium/a memory (see Robertson, Fig.1, refs. 50, 60, and 70); and a first user (e.g., a gift giver) is distinct from the second user (e.g., a gift receiver).

Conclusion

4. Claims 1-45 are not patentable.

5. Remark: Pending claims 1-45 broadly teach old features of interactive electronic commerce steps via Internet. These claims do not teach any inventive concept.

Bezos (as practice by <http://www.amazon.com>) also teaches online interactive steps:

- defining a group of related item/a gift cluster (i.e., household electronics), where
 - displaying information about that item (i.e., a 27" stereo Sony TV);
 - user add another selection to continue shopping (i.e., a Sony progressive-DVD player);
 - user wants to define a category (i.e., TV), the server matches that group;

- use a relational database to identify gift clusters and each cluster's category (e.g., a directory having sub-directories);

- a receiver selects items by sending an order request, and a sender would send related items with a single selection (merely sending a document containing related items).

6. These references are considered pertinent to applicants' disclosure:

- Anon., "Electronic Retailing: A Competitive Edge" HFD--The Weekly Home Furnishings Newspaper, vol. 57, p. 22, Dec. 19, 1983.

- Anon., "JL Hudson Will Install Customer-Operated Computers in its Bridal Registries in 9/83," HFD, Aug. 22, 1983, p. 22.

- Fox, B., "Here Comes the (New) Bridal Registry," Store Age Executive, Vol. 67, No. 10 (Section 1), pp. 58-64, Oct. 1992.

- Kehoe, A-M., "Technology Comes to Tabletop," HFD--The Weekly Home Furnishings Newspaper, May 24, 1993, p. 45.

- Barth, C., "Office Technology," Management Accounting, vol. 75, No. 6, pp. 65-66, Dec. 1993.

- Anon., "Carson's Quantum POS Leap," Chain Store Age Executive, vol. 70, No. 1 (Section 1), pp. 98-103, Jan. 1994.

- Anon., "Bridal Registry Guide Joins Service Merchandise Family," Discount Store News, vol. 33, No. 19, pp. 11, Oct. 3, 1994.

- Schwartz, D.B., "Net Sales," HFN, vol. 69, No. 8, p. 1+, Feb. 20, 1995.

Anon., "Giving the Perfect Graduation Gift Made Easy with Computerized Registry System," PR Newswire, May 2, 1995.

- Bernard, S., "A Website for Store Registries," HFN, vol. 69, No. 31, p. 27+, Jul. 31, 1995.

- Bernard, S., "Purchasing Bridal Gifts via the Net," HFN The Weekly Newspaper for the Home Furnishing Network, vol. 69, No. 44, p. 31, Oct. 30, 1995.
- Anon., "Santa Cruz, Wanting a Piece of Unix-Based Internet Action, Has 'Atlas' Products and Services to Offer," Computergram International, No. 846, Feb. 7, 1996.
- The Microsoft Press Computer Dictionary, Third Edition, Microsoft Press, pp. 31, 425, 426, and 434, 1997.
- Anon., 'New York Today' from the New York Times Makes On-Line Debut Thursday, Jun. 16, PR Newswire, Jun. 15, 1998.
- Sample, A., "The Wedding List Co. Debuts in New York," HFN, vol. 73, No. 14, p. 51+, Apr. 5, 1999.
- Anon., "Retailers Say 'I Do' to Wedding Web Site," The Wall Street Journal, vol. CCXXXIII, No. 111, p. B9, Jun. 9, 1999.
- Dorris Nixon, "75 Years of Bridal Business", [The Evolution of the Bridal Registry and the Future of the Wedding Gift Industry], Gifts & Decorative Accesories, vol. 93, No. 5, P32(3), May, 1992.
- Author unknown, "Computer System can Enhance Bridal Business", Gifts & Decorative Accesories, vol. 90, No. 6, P42(1), Jun. 1989.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose telephone number is 571-272-6759. The examiner can normally be reached on 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THOMAS G. BLACK can be reached on 571-272-6956. The Rightfax number for the organization where this application is assigned is 571-273-6759.

S.N. 09/699,244
Art Unit 3661

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Please provide support, with page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.

Cuong H. Nguyen

OKAN

CUONG H. NGUYEN
Primary Examiner
Art Unit 3661